

H3
REISSUE

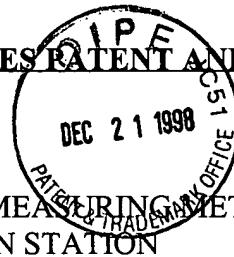
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leonard H. Bieman

Serial No.: 09/111/978

Filed: July 8, 1998

Title: SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN
OBJECT AT A VISION STATION



Docket: 139.045USR

DECLARATION OF INVENTOR

BOX PATENT APPLICATION

Assistant Commissioner for Patents

Washington, D.C. 20231

I, Leonard H. Bieman, hereby declare as follows:

1. I am a citizen of the United States residing at:
32450 Shrewsbury
Farmington Hills, MI 48334, USA.
2. I believe that I am the original inventor of the invention disclosed and claimed in U.S. Patent No. 5,646,733, issued on July 8, 1997, entitled "SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN OBJECT AT A VISION STATION," and described and claimed in the accompanying application for which I solicit a reissue patent.
3. I have reviewed and understand the contents of the specification and claims of the reissue application.
4. I do not believe that the invention set forth herein was ever known or used in the United States before the invention thereof by me.
5. I acknowledge the duty to disclose information which is material to the examination to the reissue application in accordance with 37 C.F.R. § 1.56(a).
6. After reading the opinion of outside patent counsel, I believe the above-identified patent is partially inoperative by reason of claiming less than I, the inventor, had a right to claim in the patent. Such inoperativeness includes particularly the failure to prosecute and obtain claims commensurate with the scope of new claims 28-85 filed in the reissue application.
7. More particularly, I declare that I believe the claims of the patent were determined to be

DECLARATION OF INVENTOR

Page 2

Application for Reissue of U.S. Patent No. 5,646,733 (Serial No. 08/593,095)

Docket: 139.045USR

Title: SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN OBJECT AT A VISION STATION

insufficient to protect the invention disclosed in the specification during a review of the 5,646,733 patent by Charles A. Lemaire, outside patent counsel for PPT Vision, Inc. being the assignee of the present invention, beginning in approximately September 1997 a part of an investigation of the patent prior to a license and later purchase of the patent from the original assignee, Medar, Inc., and culminating in the reissue application.

8. U.S. application Serial No. 08/593,095 was filed on January 29, 1996 with twenty-seven claims. The claims were originally rejected under 35 U.S.C. § 103 over Kuchel (5,135,308) in view of Bullock et al. (5,488,478) in a first Office Action mailed 8/13/96.
9. The claims 1 and 14 of U.S. application Serial No. 08/593,095 were amended in an Amendment and Response filed November 12, 1996. The amendment was entered accordingly and the claims as amended issued (some renumbered) as claims 1-27 in U.S. Patent No. 5,646,733.
10. After reading the opinion of outside patent counsel, I now believe that other patentably distinct independent claims are possible for claiming aspects of the invention. The existing independent claims 1 and 14 contain limitations or features which, if eliminated, result in patentably distinct claims. In particular, the requirement of moving at a substantially constant velocity and having substantially uniformly spaced detector elements are unnecessarily limiting and can be deleted without adding new matter.
11. New claim 40 is an independent claim and has eliminated the above-noted limitations present in claim 1, but contains other limitations that make it narrower than the original claim 1. New claim 42 is an independent claim and has eliminated the above-noted limitation present in claim 14, but contains other limitations that make it narrower than the original claim 1. Thus these claims avoid the prohibition against recapture of the same or broader scope of cancelled claims (*Ball Corp. v. United States*, 221 USPQ 289,295 (CAFC 1984)).
12. On information and belief, I further declare that the reasons which render U.S. Patent No. 5,646,733 partially inoperative arose without any fraudulent or deceptive intention on my part, and, as the reissue applicant, upon being informed of the significance of the

DECLARATION OF INVENTOR

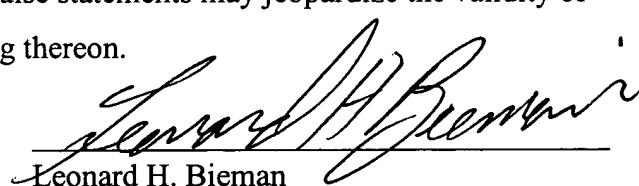
Application for Reissue of U.S. Patent No. 5,646,733 (Serial No. 08/593,095)

Docket: 139.045USR

Title: SCANNING PHASE MEASURING METHOD AND SYSTEM FOR AN OBJECT AT A VISION STATION

foregoing facts, I concur in the filing of the reissue application by the assignee.

13. I further declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further, that these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the reissue application or any patent issuing thereon.

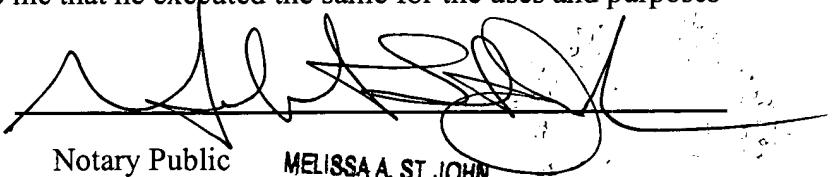
Dated: Nov 30, 1998

Leonard H. Bieman

STATE OF Michigan)
)ss.
COUNTY OF _____)

On this 30th day of November, 1998 before me personally appeared Leonard H. Bieman, to me known and known to me to be the person described in and who executed the foregoing instrument, and he duly acknowledged to me that he executed the same for the uses and purposes therein set forth.

[SEAL]


Notary PublicMELISSA A. ST. JOHN
Notary Public, Wayne Co., MI
My Commission Expires November 26, 1999
Acting in Oakland County

FULL TEXT OF CASES (USPQ2D)

All Other Cases

Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CA FC 2001)

Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CA FC 2001)

59 USPQ2D 1597

Pannu v. Storz Instruments Inc.

U.S. Court of Appeals Federal Circuit

No. 00-1482

Decided July 25, 2001

Headnotes

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Patentability/Validity — Construction of claims (§115.03)

Patent construction — Prosecution history estoppel (§125.09)

Plaintiff's reissue claim for intraocular lens is invalid on ground of improper recapture of subject matter surrendered during prosecution to avoid prior art rejections, since reissue claim eliminated limitation on shape of "haptics" element of lens, and thus is broader than corresponding claim of original patent, since this broadened aspect of claim relates to surrendered subject matter, in that shape of haptics was same subject matter that was surrendered during prosecution of original application, and since recapture was not avoided by addition, on reissue, of limitations on haptics' dimensions and positioning, which do not narrow claim in manner directly pertinent to specific aspect that was narrowed during prosecution, namely, shape of haptics.

Particular Patents

Particular patents — General and mechanical — Intraocular lens

Re. 35,525 (of 4,435,855), Pannu, universal intraocular lens and a method of measuring an eye chamber size, summary judgment of invalidity affirmed.

Page 1598

Case History and Disposition

Appeal from the U.S. District Court for the Southern District of Florida, Dimitrouleas, J.

Action by Jaswant S. Pannu and Jaswant S. Pannu M.D., P.A. against Storz Instruments Inc. for patent infringement, in which defendant counterclaimed seeking declaratory judgment of invalidity. District court granted defendant's motion for summary judgment of invalidity, and plaintiff appealed. Affirmed.

Related decision: 47 USPQ2d 1657.

Attorneys:

Michael C. Cesarano, of Senterfitt & Eidson, Miami, Fla., for plaintiffs-appellants.

Edward W. Remus and Jonathan R. Sick, of McAndrews, Held & Malloy, Chicago, Ill.; Craig E. Larson, of Bausch & Lomb Inc., Rochester, N.Y.; Rita D. Vacca, of Bausch & Lomb Surgical Inc., St. Louis, Mo., for defendant-appellee.

Judge:

Before Mayer, chief judge, Friedman, senior circuit judge, and Rader, circuit judge.

Opinion Text

Opinion By:

Opinion by
Mayer C.J.

Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A. (collectively Pannu) appeal the judgment of the United States District Court for the Southern District of Florida, *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304 (S.D. Fla. 2000), granting summary judgment for Storz Instruments, Inc. (Storz) that U.S. Patent No. Re 32,525 is invalid under 35 U.S.C. §251, the recapture rule. Because the reissued patent improperly broadened claims in a manner directly pertinent to subject matter surrendered during prosecution, we affirm.

Background

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens. The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end. In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the lens body, and the lens could be placed in either the anterior or posterior chamber of the eye.¹

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:
a lens having a width and a thickness:

a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;
and a snag resistant disc joined to the flexible strand's free end;
said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;
said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. §103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, Pannu filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16. Independent claim 16 reads as follows:

An intraocular lens comprising:
a lens body;

Page 1599

at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;
said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and
snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

Pannu raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body... which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue." The examiner accepted Pannu's arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics. Claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 (855 patent) and reads as follows:

An intraocular lens comprising:
a lens body;
at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;
said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and
snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,
said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplemental reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with *italics* indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] *at least three times* greater in [size] *width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.* The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

Pannu filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter Pannu surrendered in obtaining allowance of claim 1 of the '855 patent. The court granted Storz's motion for summary judgment of invalidity and Pannu appeals.

Discussion

"We review a district court's grant of summary judgment de novo." *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1365, 53 USPQ2d 1377, 1378(Fed. Cir. 2000). Determining whether the claims of a reissued patent violate 35 U.S.C. §251 is a question of law, which we review *de novo*. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163(Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). This legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647(Fed. Cir. 1998); *Mentor*, 998 F.2d at 994, 27 USPQ2d at 1524 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1439, 221 USPQ 289, 297(Fed. Cir. 1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Vanmoor*, 201 F.3d at 1365, 53 USPQ2d at 1378.

Page 1600

The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. See *Hester*, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174(Fed. Cir. 1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, *Westvaco Corp. v. Int'l Paper Co.*, 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed. Cir. 1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review *de novo*.").

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. *Id.* (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Id.* "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." *Id.* Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

[1] With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." *Hester*, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, Pannu's reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of Pannu's unnecessary narrowing of claim 1 must involve a corresponding broadening of the reissued claim.

Pannu argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, Pannu filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Pannu argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. *See Southwall Techs., Inc. v. Cardinal AG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue avoids the recapture rule. *See Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165; *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

The “continuous, substantially circular arc” limitation related to the shape of the haptics. The narrowing aspect of the claim on

Page 1601

reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, “if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture.” *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634(Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 (“[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up.”). In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a “continuous, substantially circular arc.” On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED

Footnotes

1 The eye is considered to have two chambers separated by the iris. The anterior chamber lies between the back surface of the cornea and front surface of the iris. Attorneys' Dictionary of Medicine and Word Finder A-280 (1995). The posterior chamber is the space between the back surface of the iris and the front surface of the crystalline lens. *Id.* at P-280.

- End of Case -

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